



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

AV

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,669	10/23/2003	Matthew Lerner	003797.00675	5871
28319	7590	10/31/2006	EXAMINER	
BANNER & WITCOFF LTD., ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1001 G STREET, N.W. SUITE 1100 WASHINGTON, DC 20001-4597				RUTLEDGE, AMELIA L
ART UNIT		PAPER NUMBER		
		2176		
DATE MAILED: 10/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/690,669	LERNER ET AL.
	Examiner Amelia Rutledge	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4-14,16-19,21-28,30-33 and 35-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-14,16-19,21-28,30-33 and 35-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 08/21/2006; Request for Continued Examination, filed 08/21/2006.
2. Claims 1, 2, 4-14, 16-19, 21-28, 30-33, and 35-43 are pending in the case. Claims 1, 13, 27, 41, and 43 are independent claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/21/2006 has been entered.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 2, 4-14, 16-19, 21-28, 30-33, and 35-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Moran, U.S. Patent No. 6,509,912, issued January 2003.**

Regarding independent claim 1, Moran teaches domain objects, programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1), and that domain objects are represented in the system by a graphic object, i.e., icon, representing an instance of the domain object. Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as part of a file or document save operation because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), therefore Moran inherently discloses that the domain objects, i.e., property values may be received as part of a file or document save operations. Compare to claim 1, *an input system that receives in electronic ink format a property value of a document or file on or accessible by the computer system as part of a file or document save operation.*

Moran teaches a storage, access, and rendering system for the domain objects (col. 6, l. 20-col. 7, l. 25), compare to claim 1, *a storage system that stores the property value of the document or file in electronic ink format; and an ink access system that allows the operating system to access the stored property value in electronic ink format; and a rendering system for rendering the stored property value in electronic ink format.*

Regarding dependent claims 2 and 4, Moran teaches that the property value in electronic ink format includes an electronic ink title for the document or file (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), and that the title may be rendered as part of a file list operation (col. 10, l. 60-col. 11, l. 31).

Regarding dependent claim 5, Moran teaches that the title may be rendered as part of a file preview operation (col. 13, l. 20-29), since Moran discloses that the user may expand the information about a domain object by double tapping on the icon, this will result in another layout of the domain object being displayed as an overlay, i.e., file preview.

Regarding dependent claims 6 and 7, Moran teaches that the title is rendered in a title bar and/or in an application bar visible on a display (col. 18, l. 64-col. 19, l. 8; Fig. 21).

Regarding dependent claim 8, Moran teaches that the input system is activated in response to a command from an application program requesting activation of electronic ink input with respect to at least one document or file in the application program, since Moran teaches that the freeform editing program requests activation of electronic ink input with respect to documents or files in the program (col. 6, l. 20-col. 7, l. 25).

Regarding dependent claims 9 and 10, Moran teaches that the received property value in electronic ink format may be assigned as an electronic ink title for the document or file (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), and that the title may be added to an existing document or file.

Regarding dependent claims 11 and 12, Moran teaches that the input system receives from a user a change to the property value in electronic ink format associated with the document or file (col. 13, l. 13-col. 14, l. 23; claim 1), and that the property value in electronic ink format includes an electronic ink title (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60).

Regarding independent claim 13, claim 13 reflects the methods implemented by the system as claimed in claim 1, and is rejected along the same rationale.

Regarding dependent claims 14 and 16-19, claims 14-19 reflect the methods implemented by the system as claimed in claims 2 and 4-7, respectively, and are rejected along the same rationale.

Regarding dependent claims 21 and 22, claims 21 and 22 reflect the methods implemented by the system as claimed in claims 8 and 9, respectively, and are rejected along the same rationale.

Regarding dependent claims 23-26, claims 23-26 are directed toward substantially similar subject matter as claimed in claims 10-12, respectively, and are rejected along the same rationale.

Regarding independent claim 27, claim 27 reflects the computer-readable medium including computer-executable instructions used by the system as claimed in claims 1, 8, and 9, and is rejected along the same rationale.

Regarding dependent claims 28 and 30-33, claims 28 and 30-33 reflect computer-readable medium including computer-executable instructions used by the system as claimed in claims 2 and 4-7, respectively, and are rejected along the same rationale.

Regarding dependent claims 35 and 36, claims 35 and 36 reflect the computer-readable medium including computer-executable instructions implemented by the system claimed in claims 8 and 9, respectively, and are rejected along the same rationale.

Regarding dependent claims 37-40, claims 37-39 are directed toward substantially similar subject matter as claimed in claims 10-12, respectively, and are rejected along the same rationale.

Regarding independent claim 41, Moran teaches domain objects, programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1), and that domain objects are represented in the system by a graphic object, i.e., icon, representing an instance of the domain object. Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as a command because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), compare to claim 41, *sending a command from an application program to an operating system, wherein the command requests activation of an electronic ink entry region for changing a property value stored in electronic ink format of a document or file on the application program.* Moran teaches a storage, access, and rendering system for the domain objects (col. 6, l. 20-col. 7, l. 25), compare to claim 41, *receiving the command in the operating system; sending a user interface including the electronic ink entry region to the application program.* Moran teaches displaying the user interface including the electronic ink entry region with the property value in electronic ink format, the electronic ink entry region adapted to receive electronic ink input to change the property value stored in electronic ink format of the document or file (Col. 8, l. 24-61; Fig. 12).

Regarding dependent claim 42, Moran teaches that the command is sent from the application program to the operating system as part of a call requesting return of the user interface and activation of a process for changing the property value stored in electronic ink format of the document or file present on the application program, since Moran teaches calls requesting return of the user interface and activation of a process for changing the property value sent from the application program to the database and operating system (col. 6, l. 20-col. 7, l. 25).

Regarding independent claim 43 and dependent claim 44, claims 43 and 44 reflect the computer readable medium including computer executable instructions used for implementing the methods as claimed in claims 41 and 42, and are rejected along the same rationale.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 2, 4-14, 16-19, 21-28, 30-33, and 35-43 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection includes the Moran patent, which is being relied upon to teach the newly claimed limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR



Doug Hutton
Primary Examiner
Technology Center 2100